




**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: Harriet E. Brichta, et al.
Serial No.: 09/244,550
Filing Date: February 3, 1999
Group Art Unit: 3622
Examiner: James W. Myhre
Title: *System and Method of Managing a Program Office*

MAIL STOP: APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

<p align="center">CERTIFICATE OF MAILING EXPRESS MAIL NO. EV 473957650 US</p> <p>I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to Mail Stop: Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.</p> <p align="center"> Willie Jiles</p> <p>Date: October 12, 2004</p>

Reply Brief

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 1.193(b)(1), in triplicate, in response to the Examiner's Answer mailed August 11, 2004.

Appellants filed an Appeal Brief on June 21, 2004, explaining clearly and in detail why the final rejection of Claims 1-9, 13-14, 16, 18-35, 38-42, and 44-63 is improper and should be reversed by the Board. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Argument

The rejection of Claims 1-9, 13-14, 16, 18-35, 38-42, and 44-63 under 35 U.S.C. § 103(a) as being unpatentable over *Knudson* is improper and should be reversed by the Board.

Appellants note that the Examiner's Answer consists of many substantially similar arguments to those presented in the Final Office Action. However, the Examiner has added a number of more detailed arguments and cited additional references not cited during prosecution. Below, to reduce the burden on the Board, Appellants specifically address these additional arguments and additional references, as well as the Examiner's response to Appellants' Appeal Brief.

I. Group 1 (Claims 1-9, 13-14, 16, 18-26, 30-35, 38-42, 44-53, and 57-63)

Appellants maintain that: (1) *Knudson*, whether considered alone or in combination with knowledge generally available to one of ordinary skill in the art at the time of invention, fails to disclose, teach, or suggest various limitations recited in Appellants' claims; and (2) the Examiner's proposed modifications to *Knudson* are improper.

A. *Knudson* Fails to Disclose, Teach, or Suggest All Elements of the Claimed Invention

Appellants maintain that assuming, for the sake of argument only, that *Knudson* suggests, teaches, or motivates a person of skill in the art to modify *Knudson* in the manner proposed by the Examiner (which it does not), *Knudson*, whether considered alone or in combination with knowledge generally available to one of ordinary skill in the art at the time of invention, would still fail to disclose, teach, or suggest various limitations recited in Appellants' claims. Appellants reiterate all of their arguments discussed in the Appeal Brief regarding this contention.

As one example, Appellants reiterate that *Knudson*, whether considered alone or in combination with knowledge generally available to one of ordinary skill in the art at the time of invention, fails to disclose, teach, or suggest, at a minimum, "upon selection of a first tactic, comprising one of the plurality of predefined tactics, by a user for use on a particular

project, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in independent Claim 1, for example. Also relevant, at a minimum, are the limitations reciting a program office management system operable to "store a plurality of predefined tactics wherein each of the plurality of predefined tactics comprises an approach taken to affect change on a project" and "associate one or more predetermined project milestone categories with at least some of the plurality of predefined tactics," as recited in Claim 1. Independent Claims 32 and 63 recite certain analogous limitations.

The Examiner reiterates certain arguments made in the Final Office Action and Appellants reiterate their arguments made in the Appeal Brief with respect to those arguments. For example, in each of independent Claims 1, 32, and 63, Appellants have specified specific actions being taken on data which are not disclosed, taught, or suggested by *Knudson*. In particular, Appellants have previously amended Claims 1, 32, and 63 to better define "tactics" and their relationship to "milestone categories" and to describe what actions are taken when a particular predefined tactic is selected by the user for a particular project. For example, Claim 1 recites that upon such selection of a first tactic, "automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic." This feature of Appellants' invention allows the operator of a project management system to obtain consistent milestone definitions for various types of tactics. As discussed in the specification, such consistency can be particularly helpful in a large organization. Additionally, milestones defined in a pre-existing project defined or managed in another project management tool may be cross-referenced or mapped to the defined tactic types of the present program office management system and methodology. Accordingly, a project managed by a conventional project management methodology or tool with its own set of milestones may be translated to the tactic types of the present system. (*See, e.g.*, Page 35, Lines 7-14)

In the Examiner's Answer, the Examiner, in purportedly reproducing his arguments from the Final Office Action, actually adds for the first time an additional reference as part of his argument. (*See* Final Office Action, Pages 6-7; Answer, Pages 7-8) This reference is Senn, James, "Analysis & Design of Information Systems," pages 800-804 ("*Senn*"). The

Examiner cites *Senn* as support for the Examiner's statement that "[s]ince the late 1950's project management software using the Program Evaluation Review Technique (PERT) and Critical Path Method (CPM) approaches have provided a defined method for inputting, managing, adjusting, and displaying tasks involved in projects, using such display formats as Gantt charts." (*See Answer*, Page 7)

Senn merely discloses that PERT charts were designed to provide a method to schedule and integrate thousands of industrial and scientific activities, a procedure for determining the project's progress, and a way to evaluate the effect of changes in the completion schedule. (Page 800) According to *Senn*, properly developed PERT charts can indicate the individual activities of a project and the time needed for each, show the interrelationship of activities, identify the proper sequence, give time estimations, isolate areas where potential problems or delays may occur, and have a means of monitoring progress on the project. (Pages 800-801) Additionally, it appears to Appellants that *Senn* merely discloses a manually-generated PERT chart or collection of PERT charts for showing the above-discussed information.

The Examiner concludes that because "Knudson explicitly discloses using the feedback pertaining to the progress and time schedule of the projects to revise project plans," "it is obvious that Knudson would be using known PERT or CPM project management software ("Project Management Tool", Figure 2) not only to define and track the tasks (milestones) involved in a project, but also to determine which type of project (tactic) was appropriate to solve the problem." (*Answer*, Pages 7-8) Even assuming this is true (which Appellants do not concede), there is still no disclosure, teaching, or suggestion in *Senn* of "associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics" or "upon selection of a first tactic, comprising one of the plurality of predefined tactics, by a user for use on a particular project, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in independent Claim 1, for example, or of modifying *Knudson* to meet at least this limitation. The Examiner's statement that "it is obvious that *Knudson* would be using known PERT or CPM project management software . . . to determine which type of project (tactic) was appropriate to solve the problem" (*Answer*,

Page 8) simply does not address the failure of *Knudson* to disclose, teach, or suggest at least these limitations recited in Appellants' claims.

The Examiner also cites for the first time two further references in support of his arguments made in response to Appellants' arguments made in the Appeal Brief. (*See* Final Office Action, Pages 6-7; Answer, Pages 7-8) These references are Duncan, William R., "A Guide to the Project Management Body of Knowledge," page 61 ("*Duncan*") and Lowery, Gwen, "Managing Projects with Microsoft Project 4.0," pages 11-25, 65-73, and 301-306 ("*Lowery*"). The Examiner argues that "[i]t would have also been obvious in a large organization with recurring similar projects (e.g. software development) to re-use pre-defined project templates in order to preclude the project managers from having to develop similar projects from scratch." (Answer, Page 8) The Examiner further states that the "project management software in use in the art at the time the invention was made utilized such templates," citing *Duncan* and *Lowery* for support. (Answer, Page 8) Appellants respectfully submit that even assuming *Knudson* could be combined or modified with the teachings of *Duncan* and *Lowery* (and that there was the required teaching, suggestion, or motivation to do so), the proposed combination would still fail to disclose, teach, or suggest, at a minimum, "associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics" and "upon selection of a first tactic, comprising one of the plurality of predefined tactics, by a user for use on a particular project, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in independent Claim 1, for example.

For example, *Duncan* merely discloses with respect to work breakdown structures (WBSs) that an "activity list . . . , or a portion of an activity list from a previous project, is often usable as a template for a new project. (Page 61) At best, this portion of *Duncan* merely discloses that certain activity lists may be used as a template for a new project. However, nowhere does *Duncan* disclose, teach, or suggest "associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics," let alone "upon such selection of a first tactic, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in Claim 1 for example.

As another example, *Lowery* is a user manual for Microsoft Project Planner 4.0. The Examiner cites numerous pages of *Lowery*, none of which disclose, teach, or suggest at least the deficiencies of *Knudson* vis-à-vis Appellants' claims. For example, pages 11-25 of *Lowery* merely disclose various screen views of projects that may be generated using Microsoft Project Planner 4.0. As another example, pages 65-73 of *Lowery* merely disclose techniques for defining the tasks and milestones of a project. Indeed, far from disclosing "upon such selection of a first tactic, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in Claim 1, *Lowery* apparently discloses manually generating the lists of tasks and milestones for a project. (See Pages 65 and 69) As another example, pages 301-306 of *Lowery* disclose using a project template containing all tasks normally done on a project. (See Page 301) *Lowery* further discloses, "If many of your projects are similar . . . create a project template to use as the basis of future projects. Each time you get a new project, just open the template, and then customize it to match the current project." (Page 301) However, nowhere do the cited portions of *Lowery* disclose, teach, or suggest "associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics," let alone "upon such selection of a first tactic, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in Claim 1 for example.

At the very minimum, none of the cited references disclose, teach, or suggest "predefined milestone categories," and thus these references, whether considered alone or in combination, fail to disclose, teach, or suggest at least "associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics" and "upon such selection of a first tactic, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic," as recited in Claim 1 for example.

For at least these reasons, even assuming for the sake of argument that it would be possible and proper under the M.P.E.P. and governing Federal Circuit cases to combine the

newly-cited references with *Knudson* and to modify *Knudson* in the manner the Examiner proposes, which Appellants dispute, the Examiner's proposed combination and modification would still fail to disclose, teach, or suggest each and every limitation recited in Appellants' independent claims, and thus fails to support a *prima facie* case of obviousness. Appellants' independent claims and their respective dependent claims are therefore patentable over *Knudson*, whether considered alone or in combination with the newly-cited references. Appellants respectfully submit that these rejections are improper and should be reversed by the Board.

B. The Examiner Still Fails to Show the Required Teaching, Suggestion, or Motivation to Modify *Knudson*

Appellants maintain that the Examiner's proposed modifications to *Knudson* are improper. In particular, Appellants respectfully submit that the Examiner has failed to show that *Knudson* provides the requisite teaching, suggestion, or motivation to a person of skill in the art to modify *Knudson* to produce the claimed invention.

In the Examiner's Answer, the Examiner argues that "Knutson shows storing many of the claimed types of data . . . which are used to produce various reports." (Answer, Page 9) The Examiner further states that "the Examiner is not attempting to modify Knutson, but is pointing out that the specific types of data claimed as being stored by the project management system would be the usual and customary types of data found in the types of data Knutson discloses as being stored." (Answer, Page 9) Appellants respectfully submit that the Examiner is in fact attempting to modify *Knudson* (and now attempts to combine *Knudson* with three new references) and has not shown the required teaching, suggestion, or motivation in *Knudson* to do so.

First, the Examiner's rejection is under 35 U.S.C. § 103(a). The M.P.E.P. provides that "in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims." M.P.E.P. § 706.02.IV. Second, the Examiner provides a number of additional references and arguments in an attempt to modify *Knudson* to achieve the limitation "upon selection of a first tactic, comprising one of the plurality of predefined tactics, by a user for use on a particular project, automatically associating with the particular

project at least one milestone having a particular milestone category that was previously associated with the first tactic,” as recited in Claim 1 for example. In the Examiner’s Grounds of Rejection section of the Examiner’s Answer, the Examiner does not point to any portion of *Knudson* as disclosing this limitation as it was amended during prosecution. (See Answer, Pages 3-4) Instead, in response to Appellants’ arguments during prosecution and in the Appeal Brief, the Examiner provides a number of arguments, and cites a number of references in support of those arguments, as to why it would have been obvious to modify *Knudson* to achieve this limitation. Appellants respectfully submit that the fact that the Examiner has not cited any portion of *Knudson* as disclosing at least this limitation is telling - it does not exist in *Knudson*. Thus, the Examiner is clearly attempting to introduce such disclosure into the *Knudson* reference. Therefore, the Examiner is necessarily attempting to modify *Knudson* to achieve the limitations recited in Appellants’ claims and must show in the cited references the requisite teaching, suggestion, or motivation to modify *Knudson* in the manner the Examiner proposes.

Moreover, the Examiner states, “Thus, the Examiner is not attempting to modify Knutson, but is pointing out that the specific types of data claimed as being stored by the project management system would be the usual and customary types of data found in the types of data Knutson discloses as being stored.” (Answer, Page 9) First, Appellants note that none of the cited references disclose, teach, or suggest “predefined milestone categories,” as recited in Appellants’ claims. Second, the Examiner’s statement fails to address his attempt to modify *Knudson* to meet the limitations of “associat[ing] one or more predefined milestone categories with at least some of the plurality of predefined tactics” and “upon such selection of a first tactic, automatically associating with the particular project at least one milestone having a particular milestone category that was previously associated with the first tactic,” as recited in Claim 1 for example. Thus, the Examiner failed to point to any portion of *Knudson* (or of any of the newly-cited references) that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention the desirability of modifying *Knudson* to disclose, teach, or suggest at least these limitations recited in Appellants’ claims, or to achieve the advantages of the claimed invention. The Examiner merely stated that “it would have been obvious” to a person of skill in the art to modify *Knudson* to achieve the claimed invention. (Answer, Page 9) Such a statement is insufficient to establish a prima facie case of

obviousness and constitutes impermissible hindsight reconstruction of the Appellants' invention.

Furthermore, Appellants respectfully submit that, with respect to the newly-cited references, the Examiner has not shown the required teaching, suggestion in the cited references to combine or modify *Knudson* in the manner the Examiner proposes.

For at least these additional reasons, the Examiner has failed to show that the proposed modifications to *Knudson* supports a *prima facie* case of obviousness. Appellants respectfully submit that these rejections are therefore improper and should be reversed by the Board.

C. The Examiner Improperly Continues to Disregard Various Limitations Recited in Certain of Appellants' Claims

Appellants note that the Examiner still has not identified where numerous limitations of dependent Claims 16, 18-31, 44-57, and 62, for example, can be found in *Knudson* because the Examiner argues that these limitations merely recite non-functional descriptive material. (See Answer, Pages 9-13) Appellants respectfully disagree and, to avoid burdening the record and for the convenience of the Board, Appellants incorporate by reference their arguments presented in the Appeal Brief.

For at least these additional reasons, *Knudson* fails to disclose, teach, or suggest the particular combinations of limitations specifically recited Appellants' claims, which are therefore patentable over *Knudson*. Thus, Appellants respectfully request that the Board reverse the Examiner's rejection of Appellants' claims under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*.

II. Group 2 (Claims 27 and 54)

Claims 27 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*. Appellants respectfully submit that these claims are clearly patentable over *Knudson*. Appellants reiterate their position detailed in the Appeal Brief with regard to the

claims of Group 2, in addition to those arguments discussed above in Section I.C as to why the Examiner must consider the limitations recited in the claims of Group 2.

For at least these reasons, *Knudson* fails to disclose, teach, or suggest the particular combinations of limitations specifically recited in dependent Claims 27 and 54. Dependent Claims 27 and 54 are therefore patentable over *Knudson*. Thus, Appellants respectfully request that the Board reverse the Examiner's rejection of Claims 27 and 54 under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*.

III. Group 3 (Claims 28-29 and 55-56)

Claims 28-29 and 55-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*. Appellants respectfully submit that these claims are clearly patentable over *Knudson*. Appellants reiterate their position detailed in the Appeal Brief with regard to the claims of Group 3, in addition to those arguments discussed above in Section I.C as to why the Examiner must consider the limitations recited in the claims of Group 3.

For at least these reasons, *Knudson* fails to disclose, teach, or suggest the particular combinations of limitations specifically recited in dependent Claims 28-29 and 55-56. Dependent Claims 28-29 and 55-56 are therefore patentable over *Knudson*. Thus, Appellants respectfully request that the Board reverse the Examiner's rejection of Claims 28-29 and 55-56 under 35 U.S.C. § 103(a) as being unpatentable over *Knudson*.

Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance of all pending claims.

Although Appellants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants



Chad D. Terrell
Reg. No. 52,279

Date: October 12, 2004

Correspondence Address:
Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201
Tel. 214-953-6812

Customer Number: **35005**